

REMARKS/ARGUMENTS

Claims 1-22 are active.

Claims 12-20 stand withdrawn but are retained for the purpose of the Office to consider rejoinder of the non-elected subject matter.

For the reasons explained below, Applicants believe the elected species is allowable and the generic claim as provided here relating to compounds of formula (I) are allowable. Therefore, claims that are otherwise within Group I but may not be within the scope of the elected specie are not indicated as being withdrawn.

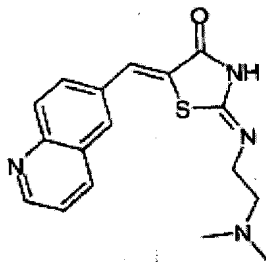
The Advisory Action indicates that the rejection under 35 USC 102(e) citing US 2006/0293338 is maintained.

Previously, that is in the final Office Action, the Examiner cited to a CAS database search corresponding to Example 107 ([00372]) in the publication. Applicants explained that this compound 107 is not within the scope of the claims. It would appear that the Examiner has agreed with this but still maintains that the provisional application of the '338 PUB discloses compounds within the scope of the claims.

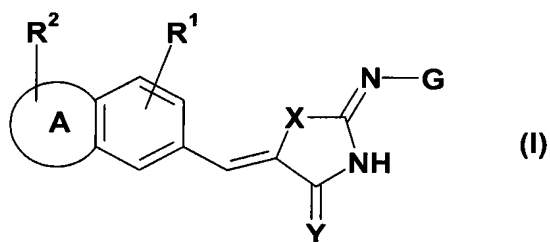
More specifically, Example 64 is cited (see page 2 of the Advisory Action). This is Example 64 from page 45 of the provisional application:

Example 64

2-(2-Dimethylamino-ethylimino)-5-quinolin-8-ylmethylene-thiazolidin-4-one



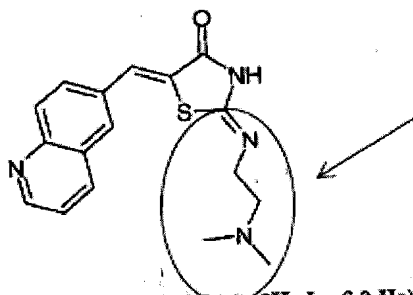
This is the compound of formula I set forth in the claims



As set forth in Claim 1 of the present application, G is “a C₁-C₆-alkoxy, C₁-C₆-alkyl, C₂-C₆-alkenyl, C₂-C₆-alkynyl, C₁-C₆-alkyl aryl, or a sulfonyl moiety” (see Amendment filed January 16, 2009). Now look again at Example 64 with emphasis added to a portion of the molecule that corresponds to “G” in the claimed formula (I).

Example 64

2-(2-Dimethylamino-ethylimino)-5-quinolin-8-ylmethylene-thiazolidin-4-one



1H NMR (CDCl₃) δ 2.80 (s, 6H), 3.24 (t, 2H, J = 6.0 Hz), 3.94 (t, 2H, J =

G in the compound of the claims cannot be the dimethyl amino substituted ethane group that is required in example 64.

Therefore, like the previous Example 107, Example 64 of the provisional application does not fall within the scope of the claims. Applicants have again reviewed the examples of the provisional application and do not find any compound falling within the scope of the claims. If the Applicants are incorrect, a detailed explanation of why that is so would be appreciated.

Therefore, Applicants again ask the Office to consider the facts that the present 371 application was filed on April 28, 2006 of a PCT application filed on July 27, 2004 and claims the benefit of EP 03102313.8 filed July 27, 2003, which fully supports the claimed invention.

The '338 publication is available as prior art against this application based on the U.S. provisional application to which it claims priority (35 U.S.C. § 102(e)) because the PCT filing date of November 18, 2003 was after the EP filing date. The provisional application of the '338 publication was filed on November 22, 2002, which is prior to the earliest date to which the present application claims priority (July 28, 2003). However, for the rejection to be valid, the provisional application must support the subject matter upon which the Examiner relied in the rejection. For the reasons explained above, the provisional application does not and as such the earliest effective prior art date of the '338 publication for the subject matter relied upon in the rejection is the date the PCT was filed (November 18, 2003). While this date is before the filing date of Applicants PCT application, it is after the date of the European Patent application, July 27, 2003.

As Applicants European priority application provides support for the claims in the present U.S. application, the '338 application is not believed to be applicable prior art under 35 USC 102(e).

Withdrawal of the rejection is requested

A Notice of Allowance is also requested.

Respectfully submitted,

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